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By: 

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BAUM et al.

Application No.: 09/630,752

Filed: August 2, 2000

For: Photographic Image Upload Kiosk
and Method

Examiner: Tim Brown

Art Unit: 3625

AMENDMENT AND RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sirs:

The Office Action rejected claims 34-43 under Section 101 as non-statutory. Claims 1-3, 5, 8, 17, 18-22, 26, 33, 45, 48, 50, 56-58 and 61-64 were rejected under Section 102(e) as anticipated by Frey (6,369,908). Claims 4, 6, 7, 10-16, 23, 25, 32, 46, 47, 49 and 51-55 were rejected under Section 103(a) as unpatentable over Frey and Official Notice. Further, claims 9, 24, 34, 35 and 37-43 were rejected under Section 103(a) as unpatentable over Frey in view of PR News article.

As discussed below, Applicants traverse the rejections and respectfully submit that all claims are in condition for allowance.

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The Section 101 Rejection

The Office Action rejected claims 34-43 under Section 101 as non-statutory. Applicants generally note that the present rejection does not establish a *prima facie* case under 35 U.S.C. § 101 and M.P.E.P. §§ 2106-2107. The Examiner bears the initial burden to establish a *prima facie* case of non-statutory subject matter and provide evidentiary support thereof. *In re Oetiker*, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). To properly make a claim rejection under 35 U.S.C. § 101, the Examiner must first make a *prima facie* showing that the claimed invention lacks utility and second provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing. M.P.E.P. § 2107.02 (IV); *In re Gaubert*, 187 U.S.P.Q. 664 (CCPA 1975). Appellant respectfully submits that a *prima facie* case has not been met, and as such a rejection on this ground should be vacated.

The Examiner has rejected independent claim 34, as well as all claims dependent thereon (claims 35-43), as being directed to non-statutory subject matter since these claims were "directed to an abstract idea in that the method of the invention fails to incorporate a tangible form of technology for the performance of the steps.

Claim 34 recites a computer-implemented method of business comprising:

- accepting image information at a first business location;
- accepting user-identifier information and order information associated with the image information at the first business location;
- processing and digitally storing a plurality of images from the image information at the first business location;
- accepting payment at the first business location;
- transferring the digital stored images to a second business location across a communications medium;
- storing the digital images at the second business location;
- processing prints of the stored images at the second business location; and
- delivering the processed prints to a customer.

The applicable standard for determining statutory process claims for computer-related inventions is set forth in the M.P.E.P. § 2106 (IV)(B)(2)(b). Although this section

initially notes that not all processes are statutory, it further qualifies this statement by noting that to be statutory,

a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Id. A claimed process is clearly statutory if it falls into one or both of these safe harbor categories. *Id.* It is respectfully submitted that the process set forth in independent claim 7 meets both of these requirements.

The first requirement that the process "result in a physical transformation outside the computer" includes any process for which certain pre-computer process activity is needed. See the section entitled "Manipulation of Data Representing Physical Objects or Activities (Pre-Computer Process Activity)" on page 2100-16. This statutory class of processes includes those which require

the measurements of physical objects or activities to be performed outside of the computer and into computer data where the data comprises signals corresponding to physical objects or activities external to the computer system, and where the process causes a physical transformation of the signals which are intangible representations of the physical objects or activities.

Id.; *In re Schrader*, 30 U.S.P.Q.2d 1455 (Fed. Cir. 1994). Of particular interest to the present claims, the claims need not set forth the actual measurement step, but rather may include those where a computer merely receives such data. See the specific example set forth in Col. 2 of page 2100-16 entitled "A method of using the computer processor to receive data representing Computerized Axial Tomography ("CAT") scanned images of a patient"; *In re Abele and Marshall*, 214 U.S.P.Q. 682 (CCPA 1982). The exemplary of that method "merely" receives data, manipulates the data, and produces more data as a result of the method. The M.P.E.P. specifically notes that the claim is allowable since

the data is an intangible representation of a physical object, i.e., portions of the anatomy of a patient. The transformation occurs when the condition of the human body is measured with X-rays and the X-rays are converted into electrical digital signals that represent the condition of the human body. The real world value

of the invention lies in creating a new CAT scan image of the body tissue without the presence of bones.

Id. Also, see first example set forth in Col. 2 of page 2100-16 entitled "A method of using a computer processor to analyze electrical signals and data representative of human cardiac activity"; *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 22 U.S.P.Q.2d 1033 (Fed. Cir. 1992). In this example, it is noted that "the data is an intangible representation of physical activity, i.e., human cardiac activity. The transformation occurs when heart activity is measured and an electrical signal is produced. This process has real world value in predicting vulnerability to ventricular tachycardia immediately after a heart attack." *Id.*

These exemplary statutory process claim examples are entirely analogous to independent claim 34 herein where the data are received, manipulated, and regenerated and are representative of images belonging to the user.

Secondly, even assuming that the first requirement is not met (which position is disputed), it is submitted that claim 34 also falls under the second requirement discussed in Col. 2 of page 2100-17 where process claims are statutory when the process is "limited to a practical application of . . . [and] . . . abstract idea or mathematical algorithm in the technological arts." In the present case, while interpolation is certainly an abstract idea which is usually expressed in the form of an algorithm, claim 34 requires that this idea or algorithm be applied to produce a practical result, i.e., the production of data sets which themselves are useful for directly producing pictures.

Applicants note that the second safe harbor for a statutory process requires that the claim be limited to a practical application. This may be met when the method produces a useful result, i.e., a functional purpose in the real world.

Hence, claim 34 clearly meets the requirements of this second safe harbor since it performs accepting image information at a first business location; accepting user-identifier information and order information associated with the image information at the first business location; processing and digitally storing a plurality of images from the image information at the first business location; accepting payment at the first business location; transferring the digital stored images to a second business location across a communications medium; storing the digital images at the second business location;

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processing prints of the stored images at the second business location; and delivering the processed prints to a customer. The accepting of image and printing of pictures is a practical application in the safe harbor.

Applicants point out that the Examiner bears the initial burden to establish a *prima facie* case of non-statutory subject matter and provide evidentiary support thereof. *In re Oetiker*, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). If the Examiner does not develop a *prima facie* case and provide evidentiary support for a rejection under 35 U.S.C. § 101, a rejection on this ground should not be imposed. *Id.* In the instant case, the Examiner has not pointed to any evidence showing that the claimed invention lacks utility. Absent any concrete evidence in the record in support of the Examiner's findings, a *prima facie* case has not been established. Hence, it is respectfully requested that the § 101 rejection of independent claim 34 (and dependent claims 35-43) be withdrawn.

The Section 102 Rejection

Claims 1-3, 5, 8, 17, 18-22, 26, 33, 45, 48, 50, 56-58 and 61-64 were rejected under Section 102(e) as anticipated by Frey (6,369,908). Frey relates to a photo kiosk containing a cpu, digital video camera, monitor, a self-contained, limited access cabinet, a payment collection device, a removable electronic storage device, a modem, a microphone, speaker, telephone line, power supply, and lights. The camera takes a picture of the user which is converted into an electronic image. The user can selectively add to the electronic image a banner message, a text message, and/or an audio message. The electronic image, optional banner message, optional text message, and optional audio message are combined into an electronic file. The user can save the electronic file on a removable electronic storage device or can send the electronic file to an electronic address which the user inputs.

Frey cannot anticipate each of the independent claims since Frey does not collect images from a plurality of customers into a kiosk, and transferring images from the kiosk to an image-processing provider. The present invention provides apparatus and methods for accepting and storing image data from each one of a plurality of customers, for example at a kiosk, then transferring and again storing the digital image data to a central processing facility for processing and distribution per instructions from the customer. As

defined on page 13 of the specification, the image processing provider can be an online photofinisher. Such centralization is convenient and advantageous in economy of scale when performing photofinishing.

In contrast, Frey's interactive photo kiosk is for creating, storing and distributing electronic images, audio messages, and text messages electronically. FIG. 2 of Frey contains a flowchart describing the basic process and the operation of the photo kiosk used for the electronic creation, storage and distribution of images, audio, and text messages. Frey is completely silent on the "image processing provider." Moreover, Frey teaches away from the claimed invention since Frey only sends data one at a time to each user.

At best, Frey shows capturing a picture, sound clip and text of one user and emailing the captured data to an email address. Frey cannot send images from a plurality of customers and transfer these images to one image processing provider, for example an on-line photofinisher. If Frey were to send all images to one email address, this would violate the user's privacy. Hence, the Office Action is incorrect in asserting that Frey shows the transferring of images from the users to the image-processing provider.

Since Frey lacks at least one element of the claimed invention, it cannot anticipate the independent claims and those dependent therefrom. Withdrawal of the Section 102 rejection is respectfully requested.

The Section 103 Rejection

Claims 4, 6, 7, 10-16, 23, 25, 32, 46, 47, 49 and 51-55 were rejected under Section 103(a) as unpatentable over Frey and Official Notice. Claims 9, 24, 34, 35 and 37-43 were also rejected under Section 103(a) as unpatentable over Frey in view of PR News article.

First, these claims overcome the Section 103 rejection because they depend from allowable independent claims. Further, Applicants note that the MPEP Section 2143.01 - Suggestion or Motivation To Modify the References - has pronounced that a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were

individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.

Applicants note that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Frey reference so as to produce the claimed invention. As noted above, the Frey reference fails to teach or suggest collecting images from a plurality of customers into a kiosk, and transferring images from the kiosk to an image-processing provider. The PR reference news article used to reject claims 9, 24, 34, 35 and 37-43 also fails to teach or suggest collecting images from a plurality of customers into a kiosk, and transferring images from the kiosk to an image-processing provider.

Further, Applicants fail to identify any motivation to modify the reference teaching so as provide transferring images from the kiosk to an image-processing provider as presently claimed. In fact, the Frey reference teaches away from Applicant's invention as one skilled in the art would have been generally discouraged from transferring images from the kiosk to an image-processing provider since Frey expressly teaches sending data one at a time to an email address.

Applicants point out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Frey, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Andreiko et al. reference, or knowledge of those skilled in the art, for interpolating positional differences to produce successive digital data sets of tooth arrangements, *prima facie* obviousness of the claims has not been established. As such, it is respectfully


requested that the § 103(a) rejection of claims, 6, 7, 10-16, 23, 25, 32, 46, 47, 49 and 51-55 be withdrawn and the claims be allowed. Similarly, the § 103(a) rejection of claims claims 9, 24, 34, 35 and 37-43 should be withdrawn.

CONCLUSION

Applicants believe that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action dated April 15, 2003.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,


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